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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,325	12/14/2000	Stephen F. Bisbee	003670-063	9515
7590	03/21/2005		EXAMINER	
Michael G. Savage, Esquire BURNS, DOANE, SWECKER & MATHIS, L.L.P. P.O. Box 1404 Alexandria, VA 22313-1404			PYZOWCHA, MICHAEL J	
			ART UNIT	PAPER NUMBER
			2137	

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/737,325	BISBEE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michael Pyzocha	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 28 February 2005.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-25 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-25 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

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**DETAILED ACTION**

1. Claims 1-25 are pending.
2. Amendment filed 02/28/2005 has been received and considered.

**Priority**

3. Based on the amendment priority to an earlier application has been accepted.

**Specification**

4. Based on the amendment the objection to the specification has been withdrawn.

**Claim Rejections - 35 USC § 112**

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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7. Claims 1-3, 5-6, 9, 17, 20-22, 25 contain the trademark/trade name "electronic original". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe an object being transferred and, accordingly, the identification/description is indefinite.

Claims 1-3, 5-6, 9-10, 13-20, 22-23, 25 contain the trademark/trade name "trusted custodial utility (TCU)". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or

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product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe an object being transferred and, accordingly, the identification/description is indefinite.

Any claims not specifically addressed are rejected by virtue of their dependencies.

***Claim Rejections - 35 USC § 101***

8. Rejections made under 35 USC 101 have been withdrawn based on the filed amendment.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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10. Claims 1-2, 5, 22-23, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graziano et al (U.S. 5,191,613) and further in view of Takaragi et al (U.S. 4,885,777).

As per claim 1, Graziano et al discloses a method of handling stored objects that have been created by signing information objects by submitting signed information objects to a trusted custodial utility (see column 14 lines 9-12 and lines 37-41), validating the submitted signed information object (see column 14 lines 18-24), establishing a rule that establishes at least one type of object, establishing at least one type of object as potential transferable records (see column 4 lines 44-63), enabling at least one selected user to access at least one selected type of object (see column 6 lines 47-56), identifying at least one type of object required to conclude a deal (see column 4 lines 47-50), controlling transformation of a selected object into a transferable record (see column 5 line 66 through column 6 line 23).

Graziano et al fails to disclose the TCU applying a date-time stamp, digital signature and authentication certificate of the TCU to each information object.

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However, Takaragi et al discloses the use of a date-time stamp, digital signature and authentication certificate (see column 7 lines 20-23).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the date-time stamp, digital signature and authentication certificate of Takaragi et al in the system of Graziano.

Motivation to do so would have been to allow a user more time to determine if any of the authentication materials are invalid (see Takaragi et al (column 7 lines 23-44)).

As per claim 2, the modified Graziano et al and Takaragi et al system discloses that based on rules established by an owner of an object requiring execution as part of concluding the deal, the TCU notifies at least one participant in the deal when the object is received by the TCU (see Graziano et al column 14 lines 60-67).

As per claim 5, the modified Graziano et al and Takaragi et al system discloses the TCU receiving a request from a user to retrieve content of an object, checking the established rule associated with the type of object identified in the request to determine whether the user has been enabled to access the type of object identified in the request (see Graziano et al column 14 lines 12-28).

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Claims 22-23 and 25 are similarly rejected to the above claims (see also Graziano et al column 11 line 15 through column 12 line 35).

***Response to Arguments***

11. Applicant's arguments filed 02/28/2005 have been fully considered but they are not persuasive. Applicant argues: "e-original," "electronic original," and "TCU" are not known to be trademarks; Graziano et al is completely silent regarding the transferring of ownership of an electronic original object, but less the recited feature of controlling transformation of a selected object into a transferable record; the date-time stamp is a current time indicator; and the motivation to combine Graziano et al and Takaragi et al.

Regarding the trademark rejections under 35 USC 112, a printout from the Trademark Electronic Search System has been provided to show the above stated terms are trademarks. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., transferring of ownership of an electronic original object) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification

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are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Graziano et al disclose controlling transformation of a selected object into a transferable record where the addition of the digital signature as described in columns 4 and 5.

Again there is no claimed limitation stating the date-time stamp is a current time indicator.

Regarding Applicant's argument that there is no motivation to combine Graziano et al with Takaragi et al is not persuasive because Takaragi et al's time-stamp allowing a grace period would give the mentioned controllability to an automatic authentication system of Graziano et al.

#### **Conclusion**

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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